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JAMES G. STAPLES ESQ  
A. FINKL & SONS CO  
2011 NORTH SOUTH PPOR T AVENUE  
CHICAGO IL 60614

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EXAMINER

WYSZOMIERSKI, G

ART UNIT

PAPER NUMBER

1742

2

DATE MAILED:

12/11/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

991113

Applicant(s)

UNDERYS

Examiner

WYSZAMIRSKY

Group Art Unit

1742

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- Of the above claim(s) 10-14 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-9 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1742

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, drawn to a process, classified in class 148, subclass 565.
  - II. Claims 10-14, drawn to an apparatus, classified in class 266, subclass 103.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another, materially different process, such as a drying process.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with James Staples on December 7, 1998 a provisional election was made with oral traverse to prosecute the invention of Group I, claims 1-9.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 1742

2. Claims 2, 3, and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 2, 3, and 5 are drawn entirely to limitations upon the apparatus used in the claimed process and do not further limit the process itself or any step thereof.

b) Claim 3 states that the lamp means used in the claimed process "is capable of" generating a high temperature, but it is unclear whether or not this temperature is actually achieved in the inventive process.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 6, 7, and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Heath '884. Heath discloses heat treating steel by subjecting the steel to the effects of an infrared heat source in a furnace. The heat source may be a tungsten filament tube (Heath column 6, line 55). The prior art process includes providing ceramic blankets to reflect infrared radiation, and includes both providing an air atmosphere and a non-air environment (Heath claim 6).

Art Unit: 1742

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heath. Heath does not specify the capabilities of the heat lamp as recited in instant claim 3. However, given that the actual heat sources used may be the same in either the prior art or the claimed invention, the examiner assumes the capabilities thereof would likewise be the same, absent evidence to the contrary. With regard to claim 9, Heath column 1, lines 29-45 discuss the problems which arise in heat treating furnaces due to oxidation and other effects of oxygen in the furnace. Based upon this disclosure, it would have been an obvious expedient to one of ordinary skill in the art to maintain a vacuum or other inert atmosphere during a heat treatment process. Consequently, the limitations as presently claimed, while not specifically recited in the Heath patent, would have been obvious to one of ordinary skill in the art from the disclosure of Heath.


7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heath, as above, in view of McGinty '876. Column 3, lines 36-38 of McGinty indicates the conventionality in the art of heat treating using infrared heat sources of utilizing gold plated reflectors in order to reflect infrared heat in a heat treating furnace. Because of this conventionality, one of ordinary skill in

Art Unit: 1742

the art would have been motivated to incorporate the metal coated reflective surface as presently claimed into the process as disclosed by Heath.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (703) 308-2531. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Prince Willis, can be reached on (703) 308-3050. The fax phone number for this Group is (703) 305-7719. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
GEORGE WYSZOMIERSKI  
PRIMARY EXAMINER  
GROUP 1400  
1742

GPW  
December 8, 1998